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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,554	04/01/2004	Pitambar Somani	3999417-144817	7144

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Porter, Wright, Morris & Arthur LLP  
ATTN: Intellectual Property Department  
28th Floor  
41 South High Street  
Columbus, OH 43215-6194

EXAMINER
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LE, LINH GIANG

ART UNIT	PAPER NUMBER
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3686

MAIL DATE	DELIVERY MODE
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04/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/815,554	<b>Applicant(s)</b> SOMANI, PITAMBAR	
	<b>Examiner</b> MICHELLE LE	<b>Art Unit</b> 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to application filed 01 April 2004. It is noted that application claims benefit to provisional application 60/459,400 filed 01 April 2003. Claims 1-26 remain pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The claimed invention is directed to non-statutory subject matter. Claims 1-26 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent- eligible. This means the machine or transformation must impose

meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Independent claims 1, 15, and 23 are directed towards a method of management for health care services. No particular machine or transformation is recited in the claim. Thus, independent claims 1, 15, and 23 and the corresponding dependent claims are non-statutory.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paetsch (Aetna enters defined contribution market. Lauren Paetsch. Employee Benefit

Plan Review. New York: Mar: 2002. vol. 56, Iss. 9; pg. 38) in view of Boyer (6,208,973).

6. As per claim 1, Paetsch teaches a method for management of health care services comprising, in combination, the steps of:  
obtaining a plurality of individual accounts for a participant at a financial institution (Paetsch; pg. 1);  
depositing at least a portion of a premium of the participant in each of their individual accounts (Paetsch; pg. 1);  
predetermining authorized health care services (Paetsch; pg. 1);

Paetsch does not expressly teach providing a debit card to the participant to access money in their individual accounts to make payments for the authorized health care services. However this is well known in the art as evidenced by Boyer. In particular, Boyer teaches a payment system access card to purchase a medical service (Boyer; Col. 4, lines 1-5). Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

7. As per claim 2, Paetsch teaches further comprising the step of predetermining authorized health care providers which can receive payment by the debit card for the

authorized health care services (Paetsch; pg. 1). Examiner submits that a PPO plan reads upon predetermining authorized health care providers which can receive payment.

8. As per claim 3, Paetsch teaches further comprising the step of negotiating fixed payments with the authorized health care providers for the authorized health care services (Paetsch; pg. 1). Examiner submits that a PPO plan reads upon negotiating fixed payments with the authorized health care providers.

9. As per claim 4, Paetsch teaches further comprising the step of obtaining high deductible health insurance for the participant (Paetsch; summary).

10. As per claim 5, Paetsch teaches further comprising the step of depositing at least a portion of the premium of the participant in one of their individual accounts for obtaining the high deductible health insurance for the participant (Paetsch; pg. 1).

11. As per claim 6, Paetsch teaches further comprising the step of depositing at least a portion of the premium of the participant in one of their individual accounts which is a savings account for obtaining health care services (Paetsch; pg. 1).

12. As per claim 7, Paetsch teaches further comprising the step of carrying over any remaining funds from a previous annual period in the savings account to discourage the participant from obtaining unneeded health care services (Paetsch; pg. 1).

13. As per claim 8, Paetsch teaches further comprising the step of depositing at least a portion of the premium of the participant in one of their individual accounts for loans to the participant and other participants who need to pay extraordinarily high deductibles (Paetsch; pg. 1).

14. As per claim 9, Paetsch teaches further comprising the step of depositing at least a fixed portion of the premium of the participant in one of their individual accounts for payment of authorized preventive health care services (Paetsch; pg. 1).

15. As per claim 10, Paetsch teaches further comprising the step of removing any remaining funds of the fixed portion from a previous annual period to encourage the participant to obtain authorized preventive health care (Paetsch; pg. 1).

16. As per claim 11, Paetsch teaches the plurality of individual accounts includes a first account, a second account, and a third account and further comprising the steps of depositing a first portion of the premium of the participant in the first account for obtaining high deductible health insurance for the participant, depositing a second

portion of the premium of the participant in the second account which is a savings account for obtaining health care services, and depositing a third portion of the premium of the participant in the third account for payment of authorized preventive health care services (Paetsch; pgs 1-2).

17. As per claim 12, Paetsch teaches further comprising the steps of carrying over any remaining funds from a previous annual period in the second account to discourage the participant from obtaining unneeded health care services, and removing any remaining funds from a previous annual period in the third account to encourage the participant to obtain preventive health care (Paetsch; pg. 1).

18. As per claim 13, Boyer teaches further comprising step of providing identification of the authorized health care services on the debit card (Boyer; Col. 7, lines 52-67). Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

19. As per claim 14, Boyer teaches further comprising step of managing any health care services which are not authorized health care services (Boyer; col. 7, lines 52-67). Since the claimed invention is merely a combination of old elements, and in the



combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

20. Claims 15-22 and 23-26 repeat substantially the same limitations as claims 1-14 thus the reasons for rejection are incorporated herein.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571) 272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

3/15/09

/M. L./

Examiner, Art Unit 3686

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686